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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/574,626	05/19/2000	Jose Remacle	VANM159.001AUS	7665
20995	7590	09/09/2004	EXAMINER	
KNOBBE MARTENS OLSON & BEAR LLP			ZHOU, SHUBO	
2040 MAIN STREET			ART UNIT	
FOURTEENTH FLOOR			PAPER NUMBER	
IRVINE, CA 92614			1631	

DATE MAILED: 09/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/574,626

**Applicant(s)**

REMACLE ET AL.

**Examiner**

Shubo (Joe) Zhou

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 16 June 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 March 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☒ None of:
- ☒ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to RCE***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed on 6/18/04 in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submissions filed on 6/18/04 have been received and considered.

Claims 1, and 3-33 are pending and under consideration.

Applicants' arguments and the Declaration under 37 CFR 1.132 by Jose Remacle filed 6/18/04 have been entered and fully considered. They have been found persuasive in view of the amended claims.

### ***Rejections Withdrawn***

2. The rejection of claims 1, 6, 28 and 33 under 35 U.S.C. § 102(e) as being anticipated by Lockhart et al. (US patent No: 6,344,316, Issued Feb. 5, 2002, Filed June 25, 1997) in the previous Office action mailed 2/17/04 is hereby withdrawn in view of the amendments to the claims.

3. The rejection of claims 1, 7-9, and 28 under 35 U.S.C. 103(a) as being unpatentable over Lockart et al. (US patent No6,344,316, Issued Feb. 5, 2002, Filed June 25, 1997) in view of Van

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Ness et al. (US patent No. 6,027,890, Issued Feb. 22, 2000, Filed July 22, 1997) in the previous Office action mailed 2/17/04 is hereby withdrawn in view of the amendments to the claims.

4. The rejection of claims 1, 3-26 under 35 U.S.C. 103(a) as being unpatentable over Abouzied et al. (Journal of AOAC International, Vol. 77, No. 2 (MAR-APR), pp. 495-501, 1994) in view of Howard III et al. (IDS document: EP 0646784A1, 05-04-95) and Van Ness et al. (US patent No. 6,027,890, Issued Feb. 22, 2000, Filed July 22, 1997), and in further view of Roth et al. (US patent # 5,902,727, Issued May 11, 1999, application filing date: Sep. 4, 1996) and Terstappen et al. (US patent # 5,646,001, July 8, 1997) in the previous Office action mailed 2/17/04 is hereby withdrawn in view of the amendments to the claims.

5. The rejection of claims 27, and 29-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Abouzied et al. (Journal of AOAC International, Vol. 77, No. 2 (MAR-APR), pp. 495-501, 1994) in view of Van Ness et al. (US patent No. 6,027,890, Issued Feb. 22, 2000, Filed July 22, 1997), and Gingeras et al. (US patent # 6,228,575, issued May 8, 2001, filed Feb. 7, 1997) in the previous Office action mailed 2/17/04 is hereby withdrawn in view of the amendments to the claims.

### ***Claim Rejections-35 USC § 112***

6. The following is a quotation of the **second** paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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7. Claims 1, 3-33 are rejected under 35 U.S.C. 112 , second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

7a). The metes and bounds of the limitation “a capture molecule” in claim 1, line 4 is unclear. It is not clear whether it is the same capture molecule as that recited in line 3.

7b). Consequently, the phrase “said capture molecule” in claim 1, lines 4-5 lacks sufficient antecedent basis because it is not clear which capture molecule it is referred to: the capture molecule recited in line 3 that was put into contact with the target molecule, or the capture molecule recited in line 4 that is bound to the target molecule. If the limitation “a capture molecule” recited in line 4 is meant “the capture molecule”, i.e. the same capture molecule as recited in line 3, it is suggested it should be so amended, and as a consequence, the phrase “said capture molecule” recited in lines 4-5 would have clear antecedent basis.

7c). Similarly, the metes and bounds of the limitation “in one or more discrete regions” recited in claim 1, line 10, and of the limitation “in discrete regions” in line 11 are unclear. It is not clear whether these discrete regions are the same regions as the “said discrete regions” recited in line 6, which are the same “at least 20 discrete regions” recited in the same line.

7d). As a result, the phrase “the discrete region(s)” recited in line 12 lacks sufficient antecedent basis because it is not clear whether it refers to the “said discrete regions” recited in line 6, or those discrete regions as recited in lines 10-11.

7e). The phrase “said metallic compound” recited in claim 3 lacks antecedent basis because the phrase “metallic compound” is not recited earlier in the claim, nor in its dependent claim 1.

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7f). Similarly to what is set forth in 7c) above, it is not clear whether the “one or more discrete region(s)” recited in claim 14, line 6 is the same as the “at least 20 discrete regions” recited in line 2.

7g). The metes and bounds of the limitation “some of said capture molecule” recited in claim 14, line 4 is unclear. It is not clear whether it is meant that the target compounds only bind to some portion of one capture molecule as it appears to be indicated by the claim as written (note the singular form of “molecule”), or that the target compounds bind to some molecules of the multiple capture molecules.

### ***Conclusion***


8. No claim is allowed.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shubo (Joe) Zhou, whose telephone number is 571-272-0724. The examiner can normally be reached Monday-Friday from 8 A.M. to 4 P.M. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward, Ph.D., can be reached on 571-272-0722. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to Patent Analyst Tina Plunkett whose phone number is (571) 272-0549.

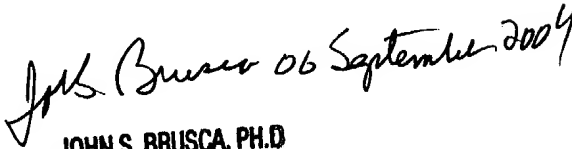
10. Patent applicants with problems or questions regarding electronic images that can be viewed in the Patent Application Information Retrieval system (PAIR) can now contact the

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USPTO's Patent Electronic Business Center (Patent EBC) for assistance. Representatives are available to answer your questions daily from 6 am to midnight (EST). The toll free number is (866) 217-9197. When calling please have your application serial or patent number, the type of document you are having an image problem with, the number of pages and the specific nature of the problem. The Patent Electronic Business Center will notify applicants of the resolution of the problem within 5-7 business days. Applicants can also check PAIR to confirm that the problem has been corrected. The USPTO's Patent Electronic Business Center is a complete service center supporting all patent business on the Internet. The USPTO's PAIR system provides Internet-based access to patent application status and history information. It also enables applicants to view the scanned images of their own application file folder(s) as well as general patent information available to the public. For all other customer support, please call the USPTO Call Center (UCC) at 800-786-9199.

Shubo (Joe) Zhou, Ph.D. 

Patent Examiner

  
JOHN S. BRUSCA, PH.D.  
PRIMARY EXAMINER